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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,415	12/12/2003	Tamotsu Ito		9097

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MATTINGLY, STANGER & MALUR, P.C.  
Suite 370  
1800 Diagonal Road  
Alexandria, VA 22314

EXAMINER
PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
2627	

MAIL DATE	DELIVERY MODE
02/26/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/733,415

Applicant(s)

ITO ET AL.

Examiner

Aristotelis M. Psitos

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/121,886.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/121886, filed on 7/24/98.

### ***Information Disclosure Statement***

The submitted IDS have been reviewed and made of record.

### ***Specification***

The current status of the applications found in the amendment of 12/12/07 with respect to the specification needs to be updated.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations with respect to claims 12/17 and 13/18 and 14/19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 12 and 17 are objected to because of the following informalities: The desired statements of intended ability, i.e., "---- enabled to be ejected ----" cannot occur since no ejection element is positively recited.

Claims 13 and 18 recited desired results, however, since the parent claim is not written in means plus function terminology, these claimed limitation do not further limit the parent claim – nor do they recite any element(s)/means to positively detect the appropriated power level and recording mode.

Claims 14 and 19 recite a desired result that cannot follow from the elements positively recited, i.e., the recording of the managing information "after reading out the intermediate information from the disk." However, because the system is drawn to a Recording apparatus, there is no "reading out" possible. Furthermore, because the claim language in both claims is identical, the examiner interprets the claim language to be more conforming to "method claims" as opposed to "apparatus claims".

The remaining dependent claims fail to clarify their parent claim and fall therewith.

Appropriate correction is required.

AS far as the claims recite positive limitations, and as interpreted by the examiner, the following rejections are made.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11,12,13,16,17 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6788346.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the mere change in claim wording, i.e.,

Present claim terms:	6788346
11	1
a camera recording apparatus	a camera information recording apparatus
a disk recording and reproducing device	lines 4-11

wherein managing information, which is the basis of managing information..... wherein managing information ....

Claims 12, and 13 are duplicative of claims 2 and 3, while claims 17 and 18 are duplicative of claims 5 and 6.

4. Claims 11,14 and 16, 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6243340 and further considered with any electronic camera (video). Although the conflicting claims are not identical, they are not patentably distinct from each other because the mere change in claim wording, i.e.,

Pending claim	Patent claim
11	1
A camera recording device	an information recording device

A camera device

electronic video camera

a system controller for controlling said  
camera recording apparatus,

system control means for ....

wherein intermediate information,  
which is a basis of managing information  
for managing the image data recorded on  
said disk, is produced and recorded on said  
disk when said system controller detects a  
decrease of the residual storage of said battery.

producing managing information  
(intermediate information) utilized  
for managing data recorded on said  
information recording medium  
when the residual storage of a battery  
Decreases, and recording managing  
information on said information recording  
medium when said residual storage of the  
battery decreases.

The ability of modify the claimed invention of 6243340 so as to be used in combination with a camera device (video camera) is considered an obvious capability, i.e., including a video camera device with the previously claimed invention expands the "recording" devices capable of taking advantage of such battery /power level recognition.

With respect to the limitations of claims 14 and 19, these are inherently present in the base patent claim, i.e., such is inherently performed.

5. Claims 14,15,19 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6788346 in view of Official notice.

With respect to the limitations of claims 15 and 19, such ability is inherently present in the above base reference/patent, i.e., the managing information is so generated.

With respect to the limitations of claims 16 and 20, such formats are well known, and Official notice is taken thereof.

It would have been obvious to modify the base patent with such additional well known formats in order to take advantage of existing formats in this environment and hence enable the final product to be compatible with well known and available recording and reproducing systems on the markets.

6. Claims 12 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6243340 in view of Yamamoto. Yamamoto teaches in this environment, the ability of having a recording device enabled to eject a disc.

It would have been obvious to modify the base patent as relied upon above in paragraph 4 with such well known ejection capabilities, motivation is to properly eject the record medium as desired.

7. Claims 13 and 18 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6243340 in view of Yoshida et al. The ability of detecting the power level (battery, etc) during the appropriate mode of operation, i.e., "recording" is taught by the reference to Yoshida et al.

It would have been obvious to modify the base patent as relied upon above in paragraph 4 with such well known operational mode systems in order to determine the power level during such a mode of operation and enable to the user to take appropriate steps/ and or to inform the user.

8. Claims 15 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6243340 in view of Official notice. The claimed formats are considered well known in this environment and Official notice is taken thereof.

It would have been obvious to modify the base patent as relied upon in paragraph 4 above with the well known formats, motivation is to produce a backward compatible record used in available recording and reproducing devices..

9. Claims 16 and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 or 2 of U.S. Patent No. 6347068 further considered with any electronic (video) camera. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the differences are merely in language and as modified below.

Pending claim	Patent claim
an image data recording method for a camera	a method of recording data on
	an information recording medium
producing the image data	digital signal processing data to be
	recorded on said recording medium
	-output of an electronic (video) cameras
	Image detecting element(s)

wherein intermediate information, which is a basis of managing information for managing the image data recorded on said disk, is produced and recorded on said disk when a decrease in the residual storage of said battery is detected.

see below with respect to  
claim 19

Claim 19,

.... according to claim 16, wherein the managing information is generated and recorded on the disk after reading out the intermediate information from the disk.

wherein ... recording on said information recording medium a managing information utilized for managing the data recorded on said information recording medium.

With respect to the ability of incorporating/modifying the above patented claim so as to include/be used in a camera (image) recording device, such is considered an obvious ability, i.e., video (image) cameras are known to record image data, and Official notice is taken thereof.. The composite ability of recording image and toc/addressing data together in a camera system is considered an obvious expediency, i.e., permit a user to know where the last recorded position/address is at low power, so as to permit the user to start recording at the next point in the medium.

10. Claim 17 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1/2 of U.S. Patent No. 6347068 as relied upon in paragraph 9 above and further in view of Yamamoto.

Yamamoto teaches in this environment, the ability of having a recording device enabled to eject a disc.

It would have been obvious to modify the base patent as relied upon above in paragraph 9 with such well known ejection capabilities, motivation is to properly eject the record medium as desired.

11. Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1/2 of U.S. Patent No. 6347068 as relied upon in paragraph 9 above and further in view of Yoshida et al.

The ability of detecting the power level (battery, etc) during the appropriate mode of operation, i.e., "recording" is taught by the reference to Yoshida et al.

It would have been obvious to modify the base patent as relied upon above in paragraph 9 with such well known operational mode systems in order to determine the power level during such a mode of operation and enable to the user to take appropriate steps/ and or to inform the user.

12. Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1/2 of U.S. Patent No. 6347068 as relied upon above in paragraph 9 and further in view of Official notice.

The claimed formats are considered well known in this environment and Official notice is taken thereof.

It would have been obvious to modify the base patent as relied upon in paragraph 9 above with the well known formats, motivation is to produce a backward compatible record used in available recording and reproducing devices.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thru: 6:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2627



AMP